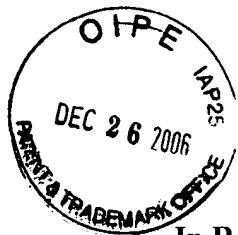


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DOCKET NO.: IVOO-0145

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Charles Eric Hunter, Bernard L. Ballou, Jr.,
Kelly C. Sparks and John H. Hebrank

Confirmation No.: 8435

Application No.: 09/707,273

Group Art Unit: 3661

Filing Date: November 6, 2000

Examiner: Cuong H. Nguyen

For: MUSIC DISTRIBUTION SYSTEM

EXPRESS MAIL LABEL NO: EV 800288990 US
DATE OF DEPOSIT: December 26, 2006

EV800288990US

MS Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPEAL BRIEF TRANSMITTAL
PURSUANT TO 37 CFR § 41.37**

Transmitted herewith in triplicate is the Third Amended APPEAL BRIEF in this application with respect to the Notice of Appeal received by The United States Patent and Trademark Office on **12/27/05** and further in response to a third Notice of Non-Compliant Appeal Brief dated November 30, 2006, with a response thereto due in 1 month or 30 days, or by **12/30/06**.

- ☐ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of _____ to and through _____ comprising an extension of the shortened statutory period of _____ month(s).

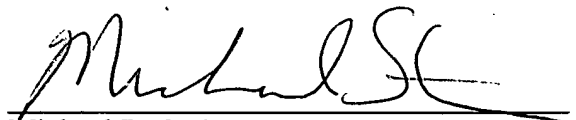
DOCKET NO.: IVOO-0145

PATENT

	SMALL ENTITY		NOT SMALL ENTITY	
	RATE	FEE	RATE	FEE
<input checked="" type="checkbox"/> APPEAL BRIEF FEE	\$250	\$	\$500	\$500.00
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME	\$60	\$	\$120	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME	\$225	\$	\$450	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME	\$510	\$	\$1020	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME	\$795	\$	\$1590	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME	\$1080	\$	\$2160	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID	minus	(\$)	minus	(\$500.00)
TOTAL FEE DUE		\$0		\$0.00

- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.
- ☐ A check in the amount of \$.00 is attached. Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.
- ☐ Please charge Deposit Account No. 23-3050 in the amount of \$.00. This sheet is attached in duplicate.
- ☒ The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 23-3050.

Date: December 26, 2006


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Charles Eric Hunter, Bernard L. Ballou,

Jr., Kelly C. Sparks, and John H. Hebrank Confirmation No.: **8435**

Application No.: **09/707,273**

Group Art Unit: **3661**

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Examiner: **Cuong H. Nguyen**

For: **MUSIC DISTRIBUTION SYSTEMS**

EXPRESS MAIL LABEL NO: EV 800288990 US
DATE OF DEPOSIT: December 26, 2006

Mail Stop Appeal-Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT
APPEAL BRIEF (37 CFR 41.37)**

APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. § 41.37

This brief is being filed in support of Appellants' appeal from the rejections of claims 40-72 dated September 26, 2005. A Notice of Appeal was filed on December 27, 2005 and a Notice of Panel Decision from Pre-Appeal Brief Review was issued on February 7, 2006. Note that an original appeal brief was filed on March 7, 2006. A first amended appeal brief pursuant to a notice of non-compliance was filed on June 14, 2006. A second amended appeal brief pursuant

to a second notice of non-compliance was filed on November 9, 2006. This brief is a third amended appeal brief which is modified from the second amended appeal brief pursuant to a notice of non-compliance dated November 30, 2006.

1. REAL PARTY IN INTEREST

Ochoa Optics LLC, an entity of Intellectual Ventures LLC, is the real party in interest in the present application.

2. RELATED APPEALS AND INTERFERENCES

A Notice of Appeal accompanied by a Pre-appeal Request for Review was filed in the related cases below:

09/645,087

09/675,025

09/684,442

11/085,944

3. STATUS OF CLAIMS

A. Claims 40-72 are pending in this present application and are reproduced in Appendix A attached hereto. There are 3 independent claims: 40, 64, and 69.

B. No claims stand allowable.

C. Claims 1-39 are cancelled.

D. Claims 40-42, 48, 50, 52-54, 60, 62, and 64-71 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schulhof (U.S. 5,572,442). Claims 43-47, 49, 51, 55-57, 61, 63

and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulhof (U.S. 5,572,442) alone or in view of McMillen (U.S. 5,483,535). No grounds of rejection were given for claims 58 and 59. However, these claims are computer readable medium claims that correspond to (and depend from) rejected claims 46 and 47.

E. Claims 40-72 are the subject of the appeal.

4. STATUS OF AMENDMENTS

No amendments to claims 40-72 have been filed subsequent to the final rejection dated September 26, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Caim#	Summary	Specification Pages, Line Numbers, and Drawings
40	In exemplary aspects, the system automatically charges a consumer for a music selection made by the consumer. The charging is triggered upon the consumer recording the music selection on a storage medium located at a consumer site.	Specification page 27, lines 5-10, page 29, lines 5-10, page 10 lines 10-12, Figs. 12 and 13 and Fig. 16 reference characters 28, 120, 130, and 135.
52	In exemplary aspects, the computer readable medium has instructions stored thereon for automatically charging a consumer for a music selection made by the consumer. The charging is triggered upon the consumer recording the music selection on a storage medium located at a consumer site.	Specification page 27, lines 5-10, page 29, lines 5-10, page 10 lines 10-12, Figs. 12 and 13 and Fig. 16 reference characters 28, 120, 130, and 135.
64	In exemplary aspects, a consumer is informed that the music selection is available for purchase if said music selection is about to be made at a peer-to-peer music sharing system used by said consumer. A mechanism is provided for the consumer to order said music selection while at a website of said peer-to-peer music sharing system.	Specification page 42, lines 10-24 and Fig. 16.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The rejection under 35 U.S.C. § 102(b) of claims 40-42, 48, 50, 52-54, 60, 62, and 64-71 as allegedly anticipated by Schulhof.

B. The rejection under 35 U.S.C. § 103(a) of claims 43-47, 49, 51, 55-57, 61, 63 and 72 as allegedly unpatentable over Schulhof alone and/or Schulhof in view of McMillen.

7. ARGUMENT

Regarding ground of rejection A above, Appellants respectfully traverse the Examiner's rejection of claims 40-42, 48, 50, 52-54, 60, 62, and 64-71 under 35 U.S.C. § 102(b) as being allegedly anticipated by Schulhof.

A. Rejections under 35 USC § 102(b)

i. Claim 40

Claim 40 is rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Schulhof et al. (U.S. 5,572,442).

Appellants respectfully submit that Schulhof does not disclose the subject matter of claim 40. The 9/26/2005 final Office Action describes how in Schulhof, orders for music selections are communicated and then transferred to the consumer for recording at the consumer site.

Fig. 7 shows a request for available music from a customer (ref.204) and "Info Request Manager" 22 would fulfill that request by transmitting from "Satellite Distribution System" 200....In Fig. 7, Schulhof et al. teach about communicating an order of said music selection to a central controller "Info Request Manager" 22), transferring copies of records of records of said order to a

transmission scheduler (See Schulhof et al., col. 1, lines 64-67);
communicating schedules created by said transmission scheduler
to a satellite uplink facility for transmission of said order; and
transmitting via satellite said order to said customer site.

Final Office Action mailed 9/26/2005, page 2.

However, the final Office Action is silent on how and when the consumer is charged or billed for these orders. In fact, Schulhof et al. teaches or suggests that the consumer is charged at the time of ordering, as opposed to “upon the consumer recording the music selection on a storage medium located at a consumer site,” according to claim 40.

Schulhof states in column 7, line 61 to column 8, line 8:

When the subscriber has completed placing the order, a payment icon is displayed that requires the subscriber to authorize billing to his account. The subscriber may request materials on a one-time basis, which for purposes of the invention is referred to as audio on-demand, for example he may want to listen to a symphony; or he may want to receive information on a daily or other periodic basis, which for purposes of the invention is referred to as an audio subscription. These decisions may be made during order placement, and may be canceled or revised at any time by accessing the distribution system.

Once the order process is completed, high speed data transfer may begin, or data transfer may be delayed until a time when the cable television line is not being used to supply television programming, e.g. 2:00 A.M.

As shown above, it is stated in Schulhof in column 7, lines 61-63 that “when the subscriber has completed placing the order, a payment icon is displayed that requires the subscriber to authorize billing to his account.” This is opposed to charging the consumer “triggered upon the consumer recording the music selection on a storage medium located at a consumer site,” as appears in claim 40. In Schulhof, only after this payment process is completed does the high speed transfer begin. This is shown above where Schulhof states “once the order process is completed, high speed data transfer may begin.” Col. 8, lines 5 -6. Therefore, this indicates as well that the payment or charging in Schulhof is not “triggered upon the consumer recording the music selection on a storage medium located at a consumer site,” as appears in claim 40.

Also, in Schulhof the “program includes a header that ...identifies the use allocation of the material,” and “actual use may be assigned as a function of the amount paid by the subscriber.” Therefore, the header contains the previous payment information for the music program to be transmitted to the user, which means the user has already been charged for the program before it is recorded at the consumer site. This is also opposed to charging the consumer “triggered upon a recording by the consumer of the music selection on a storage medium located at a consumer,” as appears in claim 40. Thus, for the reasons above and others, Appellants submit that all the limitations of rejected claim 40 are not taught or suggested by Schulhof et al.

Therefore, reversal of the rejection under 35 U.S.C. § 102(b) of claim 40 is earnestly solicited.

ii. Claims 41-42, 48, 50, 52-54, 60, 62, and 64-71

Claims 41-42, 48, 50, 52-54, 60, 62, and 64-71 either depend directly or indirectly from claim 40, or were rejected for the same reasons with respect to the element related to charging the consumer “triggered upon a recording by the consumer of the music selection on a storage medium located at a consumer.” Thus, Appellants submit that all the limitations of these claims are not taught or suggested by Schulhof for at least the same reasons presented above.

Therefore, reversal of the rejections under 35 U.S.C. § 102(b) for claims 41-42, 48, 50, 52-54, 60, 62, and 64-71 is earnestly solicited.

Regarding ground of rejection B above, Appellants respectfully traverse the Examiner’s rejection of claims 43-47, 49, 51, 55-57, 61, 63 and 72 as allegedly unpatentable over Schulhof alone or in view of McMillen.

B. Rejections under 35 USC § 103(a)

i. Claims 43-47, 49, 51, 55-57, 61, 63 and 72

Claims 43-47, 49, 51, 55-57, 61, 63 and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulhof alone or over Schulhof in view of McMillen.

Claims 43-47, 49, 51, 55-57, 61, 63 and 72 either depend directly or indirectly from claim 40, or were rejected for the same reasons with respect to the element related to charging the consumer “triggered upon a recording by the consumer of the music selection on a storage

medium located at a consumer.” Thus, Appellants submit that all the limitations of these claims are not taught or suggested by Schulhof et al., any of the other references cited by the Office Action, or any combination thereof, for at least the same reasons presented above.

ii. Claim 43

Furthermore, claim 43 states:

43. The method of claim 40 further comprising:
informing the consumer that the music selection is
available for purchase if said music selection is about to be made at
a peer-to-peer music sharing system used by said consumer; and
providing a mechanism for the consumer to order said
music selection while at a website of said peer-to-peer music
sharing system.

The final Office Action contends that the limitations of claim 43 above regarding “informing the consumer that the music selection is available for purchase if said music selection is about to be made at a peer-to-peer music sharing system used by said consumer,” is described by McMillen, stating that “McMillen et al. suggest a use of a peer-to-peer communication network for music trans-receiver/sharing.” Final Office Action mailed 9/26/2005, page 4.

McMillen describes enabling “a peer-to-peer token ring network to be implemented using a relatively inexpensive master-slave serial communications controller...to connect a station at any node of the newtwork.” Col. 2, lines 9-13. Although McMillen speaks of using peer-to-peer networks generally, and of a particular way of using a peer-to-peer network (e.g., adapting a device operating in master-slave mode to a token ring network in peer-to-peer mode), there is no

description of “informing the consumer that the music selection is available for purchase if said music selection is about to be made at a peer-to-peer music sharing system.” This “informing the consumer,” would be, for example, to give the consumer the option to purchase the music rather than proceed with procuring the music selection on a peer-to-peer sharing system. In fact, as shown in the excerpt below from McMillen, the network described in McMillen is described for use in music synthesis, rather than music selection.

An example of a communications network with which the present invention can be used is one which connects one or more musical instruments, computers and synthesizers so that the connected equipment can be used to create and play synthesized music.

McMillen, Col. 1, lines 12-16.

There is no description in McMillen of a “music selection” that “is about to be made at a peer-to-peer music sharing system a music,” nor of “informing the consumer that the music selection is available for purchase.” McMillen merely describes a system that involves a utilizing a peer-to-peer network, rather than “informing the consumer that the music selection is available for purchase.”

iii. Claims 58 and 59

No grounds of rejection were given by the Examiner for claims 58 and 59. However, these claims are directed to a computer readable medium having computer executable instructions stored thereon for performing the method of claims 46 and 47, respectively, and thus are allowable for same the reasons presented above as for claims 46 and 47.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 43-47, 49, 51, 55-59, 61, 63 and 72 are not taught or suggested by Schulhof, McMillen or any combination thereof, for at least the reasons presented above, reversal of the rejections under 35 U.S.C. § 103(a) for claims 43-47, 49, 51, 55-59, 61, 63 and 72 is earnestly solicited.

8. CLAIMS APPENDIX

1-39. (Canceled).

40. (previously presented) A method comprising:
automatically charging a consumer for a music selection made by the consumer, said charging triggered upon the consumer recording the music selection on a storage medium located at a consumer site.

41. (previously presented) The method of claim 40 wherein the automatically charging is done electronically.

42. (previously presented) The method of claim 40 wherein the charging comprises:
receiving music selection information from a consumer site at a central controller system upon a recording by the consumer of the music selection on a storage medium located at a consumer site; and

billing the consumer for each recorded music selection that is made available for playback.

43. (previously presented) The method of claim 40 further comprising:
informing the consumer that the music selection is available for purchase if said music selection is about to be made at a peer-to-peer music sharing system used by said consumer; and
providing a mechanism for the consumer to order said music selection while at a website of said peer-to-peer music sharing system.

44. (previously presented) The method of claim 43 further comprising:

paying an operator of said peer-to-peer music sharing system for advertising and making music available for purchase.

45. (previously presented) The method of claim 43 wherein the informing comprises: placing a highlight within a catalog of said peer to peer music sharing system whenever catalog selections are available.

46. (previously presented) The method of claim 43, wherein the informing comprises: placing an icon within a catalog of said peer to peer music sharing system whenever catalog selections are available.

47. (previously presented) The method of claim 43, further comprising: creating a profile from consumer preference information provided by said peer-to-peer music sharing system.

48. (previously presented) The method of claim 40 further comprising: transmitting to the consumer site, for storage on the storage medium at the consumer site, information identifying available music selections for recording on the storage medium.

49. (previously presented) The method of claim 48 further comprising: before charging the consumer for the music selections, transmitting the content of the music selection to the consumer site for recording of the content of the music selection on the storage medium by the consumer.

50. (previously presented) The method of claim 49, wherein said transmitting comprises:
communicating an order of said music selection to a central controller;
transferring copies of records of said order to a transmission scheduler; communicating schedules created by said transmission scheduler to a satellite uplink facility for transmission of said order;
transmitting via satellite said order to said customer site.

51. (previously presented) The method of claim 50, wherein said order communication comprises:

an action selected from the group consisting of: using a home personal computer for ordering said music selection, using a cell phone for ordering said music selection, using a Personal Data Assistant wireless device for ordering said music selection; ordering said music selection is via wireless application protocol.

52. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 40.

53. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 41.

54. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 42.

55. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 43.

56. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 44.

57. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 45.

58. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 46.

59. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 47.

60. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 48.

61. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 49.

62. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 50.

63. (previously presented) A computer readable medium having computer executable instructions stored thereon for performing the method of claim 51.

64. (previously presented) An apparatus comprising:
a recording detection mechanism configured to automatically charge a consumer for a music selection made by the consumer, said charging triggered upon the consumer recording the music selection on a storage medium located at a consumer site.

65. (previously presented) The apparatus of claim 64 further wherein the recording detection mechanism is configured to automatically charge electronically.

66. (previously presented) The apparatus of claim 64 wherein the recording detection mechanism comprises:

a receiving mechanism configured to receive music selection information from a consumer site to a central controller system upon a recording by the consumer of the music selection on a storage medium located at a consumer site; and

a billing mechanism configured to bill the consumer for each recorded music selection that is made available for playback.

67. (previously presented) The apparatus of claim 64 further comprising:
a transmitting mechanism, operable with the recording detection mechanism, configured to transmit to the consumer site, for storage on the storage medium at the consumer site, information identifying available music selections for recording on the storage medium.

68. (previously presented) The apparatus of claim 67 wherein the transmitting mechanism further comprises:

a music content transmitting mechanism configured to, before charging the consumer for the music selections, transmit the content of the music selection to the consumer site for recording of the content of the music selection on the storage medium by the consumer.

69. (previously presented) An apparatus comprising:

a recording device configured to enable automatic charging of a consumer for a music selection, said charging triggered upon the consumer recording the music selection on a storage medium located in the recording device.

70. (previously presented) The apparatus of claim 69 further comprising:

a mechanism configured to enable automatic charging of the consumer for playing the recorded music selection, said charging automatically triggered upon each playing from the storage medium of the music selection recorded by the consumer on the recording device.

71. (previously presented) The apparatus of claim 69 further comprising:

a music information receiving mechanism configured to receive, for storage on the storage medium at the consumer site, information identifying available music selections for recording on the storage medium.

72. (previously presented) The apparatus of claim 71 wherein the music information receiving mechanism further comprises:

a music content receiving mechanism, configured to receive, before charging of the consumer for the music selection, content of the music selection to the consumer site for recording of the content on the storage medium by the consumer.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.

Conclusion

Appellants thus submit that claims 40-72 patentably define over Schulhof in view of McMillen, and any other reference of record, taken alone or in combination. For all the foregoing reasons, Appellants respectfully request that the Board reverse the rejections of claims 40-72.

Date: December 26, 2006

A handwritten signature in black ink, appearing to read "Michael D. Stein", written over a horizontal line.

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